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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,490	12/11/2003	Mark Zdeblick	PRTS-012	1638
61487 7590 04/16/2008 BOZICEVIC, FIELD & FRANCIS LLP (PROTEUS BIOMEDICAL, INC) 1900 UNIVERSITY AVENUE, SUITE 200 EAST PALO ALTO, CA 94303				
EXAMINER NASSER, ROBERT L				
ART UNIT 3735		PAPER NUMBER		
MAIL DATE 04/16/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,490

Applicant(s)

ZDEBLICK ET AL.

Examiner

ROBERT L. NASSER

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-52 and 54-95 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 6, 54-56 and 69-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-52, 57-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/10/2008 has been entered.

Claims 1-3, 6-47, 54-56, and 69-95 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/29/2007.

Claims 48-52 and 57-65 are objected to in that there is no antecedent basis for the on common electrical conductor in line 7, as the basis is for simply one conductor.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48-52, and 57-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al 6163716. Edwards shows a device including a body

including catheter 118 and ferrule 132, a plurality of effectors mounted on the attached to the body, where each effector is composed of chip 106 with an identifiable microprocessor 92, and spline 76. Each spline has sensing and ablation electrodes. In figures 22 and 24, as discussed in column 10, lines 16-24, each effector is connected to a common power line, as there is only one power line for the entire device. Also, the power lines extend connect to the effector through cone points 138, which penetrate the top surface of ferrule 132. Hence, the common conductor, i.e. the power line, connects to the effector through a surface penetration. As to the order of assembly, in Edwards, one effector is connected then another, and the coupling step and mounting steps occur simultaneously. However, applicant has not stated that the order of the steps is for a particular purpose or that it solves a stated problem. The end result of both methods is an identical device, i.e. a tube with a plurality of effectors mounted thereon. Hence, the exact order of the assembly steps would have been a mere matter of design choice for one skilled in the art. Claim 49 is rejected in that the term "cardiac pacing" is an intended use limitation and is met if the reference is capable of the use. Here, structurally, a lead is a lead and hence the lead of Edwards is a pacing lead. Claims 57-61 are rejected in the effectors include an ablation actuator, i.e. it provides electric current and/or heat and also Edwards teaches that the electrodes can be sensing electrodes, which sense electrical potential. Claims 66 and 67 are rejected in that Edwards has in figures 22 and 24, as discussed above, 2 leads 122 and 124 which are common to all the effectors. Claim 68 is rejected in that there is an electrical circuit.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50, 51, 63, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. Claim 50 is rejected in that there are multiple conductors extending outwardly through the body from the effector. However, there is only one lumen in the body. Applicant has not stated that having a separate lumen for each conductor solves a stated problem or is for a particular purpose. Therefore, it is the examiner's position that the number of lumens would have been a mere matter of design choice for one skilled in the art. Claim 51 is rejected in that there are multiple splines, hence multiple effectors mounted through one or more surface penetrations. Claims 63 and 64 are rejected in that there are 3 leads emanating from the effectors, including power and data. The examiner notes that there inherently is a ground lead as well. Claim 65 is rejected in that at least a portion of the leads are encapsulated by solder.

Applicant's arguments filed 12/28/2007 have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT L. NASSER whose telephone number is (571)272-4731. The examiner can normally be reached on m-f 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert L. Nasser Jr/
Primary Examiner
Art Unit 3735

RLN
March 28, 2008